

Remarks

The Applicants acknowledge the comments concerning the claim of priority. The Applicants respectfully submit that they have completed the conditions for the priority claim. The rejection cites MPEP 201.15 as supporting the need for a certified translation.

MPEP 201.15 is titled “Right of Priority, ***Overcoming a Reference.***” That section states, “[t]he only times during *ex parte* prosecution that the examiner considers the merits of an applicant's claim of priority is ***when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States and when an interference situation is under consideration.***” (emphasis added).

The Applicants do not seek to overcome a reference based on their claim of priority. The Applicants, therefore, respectfully submit that certified English translations of the priority documents are not required unless the Applicants seek to use those priority documents to overcome a rejection based on prior art. Confirmation of acceptance of the Applicants’ claim of priority, as opposed to the use of that claim of priority, is respectfully requested.

Claims 1, 3, 5, 7, 17, 19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizaki. The Applicants respectfully submit that Ishizaki fails to provide teachings that render the solicited claims obvious and respectfully request reconsideration and withdrawal of the obviousness rejection.

Claims 1 and 17 recite, “the hot-rolled steel strip is composed of bainitic ferrite as a primary phase at a content of about 95 percent by volume or more . . . and wherein the ratio in percent of the amount of precipitated Nb to the total amount of Nb is from 5 to about 80%.” Claim 1 adds that the steel has a yield strength of at least 560 MPa.” Claim 17 adds that the steel has a CTOD value of

.25mm or more.

According to the rejection, Ishizaki discloses these elements at col. 5, lns. 12-15 because it discloses that the steel is comprised of uniform and very fine ferrite grains with some upper bainite.

The Applicants respectfully submit that the cited portion of Ishizaki does not disclose that the steel is composed of bainitic ferrite as a *primary phase* at a content of about **95 percent by volume or more**. The cited portion of Ishizaki states only that Ishizaki's processes produces "very fine ferrite grains . . . and the content of upper bainite in the steel after rolling can also be reduced remarkably."

Further, the Applicants respectfully submit that one skilled in the art would not seek to include bainitic ferrite as a primary phase at a content of about 95 percent by volume or more in Ishizaki's steel. The claimed steel microstructure is composed of 95 % bainitic ferrite as a primary phase to ensure strength and toughness. *See* paragraph [0044] of the originally-filed Specification. The high yield strength and high CTOD strength are achieved because the steel comprises the aforementioned percentage of bainitic ferrite and the precipitation ratio of Nb.

Conversely, Ishizaki discloses *reducing* the amount of upper bainite. *See* col. 5, lns. 12-15 ("the content of upper bainite in the steel after rolling can also be **reduced remarkably**.") Moreover, in sharp contrast to the rejected claims, Ishizaki discloses that the upper bainite is reduced remarkably because upper bainite would weaken Ishizaki's steel. *See e.g.*, Ishizaki, col. 2, lns. 5-17. Further, Ishizaki does not disclose a high yield strength or CTOD of its steel or that a relatively strong steel is attainable with a particular phase ratio and Nb precipitation ratio as claimed.

Finally, the novel steel claimed, by including the aforementioned percentage of bainitic ferrite, provides advantages over the steel disclosed in Ishizaki. The yield strength of the claimed steel is 560 MPa at a minimum. *See* Claim 1, paragraph [0065] of the originally-filed Specification.

In sharp contrast, Ishizaki discloses a steel with 50.8 kg/mm^2 , which is only 498 MPa. *See* Table 6 of Ishizaki. The unique properties of the above rejected claims and advantages over the prior structures are further evidence that the claimed steel is not disclosed or suggested by Ishizaki or the other cited references.

For the foregoing reasons, Ishizaki would not suggest, to one skilled in the art, to use a relatively high percentage (i.e., 95 %) of bainitic ferrite in its steel a primary phase. Therefore, the Applicants respectfully submit that Ishizaki does not render Claim 1 obvious, making Claims 1 and 17 allowable. Because Claims 1 and 17 are allowable, the remainder of the claims, which depend from Claims 1 and 17, are also allowable.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizaki in view of Unrath. The rejection concedes that Ishizaki fails to disclose forming a pipe as recited in Claims 25 and 26. Nevertheless, the rejection finds that Unrath discloses utilizing strip metal in coil form and welding the strip to form pipes for such uses as high pressure lines, boilers, oil well casing. The rejection also finds that it would have been obvious to one skilled in the art to weld Ishizaki's strip to form pipes, as disclosed by Unrath for use in high pressure lines, boilers, etc. The Applicants respectfully submit that one skilled in the art would not seek to combine Unrath and Ishizaki. Ishizaki does not disclose or suggest that its steel is or can be used in forming ERW pipe. Therefore, one skilled in the art would not be motivated to make such pipes based on Ishizaki. For these reasons, the Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claims 25 and 26.

In addition, the rejection provides that Ishizaki's steel would be electrically resistant because Ishizaki discloses substantially the same composition. The Applicants respectfully submit that Ishizaki does not disclose substantially the same composition as that of Claims 25 and 26, for the

reasons provided above.

Finally, as provided in the Applicants' August 9, 2007 Response, Ishizaki does not disclose the ratio of the amount of precipitated Nb in a finished hot-rolled steel strip. These arguments were not considered because the finished feature was not claimed. Although Ishizaki discloses in col. 3, lns. 45-64 that the amount of precipitated Nb is 0.02% (1/3 of precipitated Nb, at low temperature rolling), this is an amount of precipitation from the *start* of rolling to the initiation of ferrite precipitation. The Applicants invite the Examiner's attention to lines 49-51 in particular. However, there is no disclosure of the precipitation ratio in a *finished* hot-rolled steel in Ishizaki. In that regard, new Claim 27 recites that the coiled, hot-rolled steel strip according to Claim 1 is finished. Support for Claim 27 is found at paragraphs [0020], [0050] and [0057] of the originally-filed Specification.

In general, Nb carbonitride precipitates partially during ferrite transformation. However, Ishizaki uses steel containing high carbon quantities outside the claimed range. From this, excessive precipitation of Nb carbonitride is very likely and the Applicants' CTOD toughness is not obtained.

The Applicants respectfully submit that Ishizaki would actually lead one skilled in the art away from the subject matter of Claims 25 and 26 inasmuch as Ishizaki relates to the amount of precipitation from the start of rolling to the initiation of ferrite precipitation, but not the precipitation ratio of a finished hot-rolled steel as in the Applicants' Claims 25 and 26. Thus, the Applicants respectfully submit that Ishizaki can hardly render those claims obvious. Withdrawal of the rejection is respectfully requested.

In light of the foregoing, the Applicants respectfully submit that the entire application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



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